

No new matter is added by the amendment.

Remarks

In the Office Action dated May 20, 2005, the Examiner rejected claims 15-21 and 23-25 as obvious under 35 U.S.C. 103(a) over Vichai in view of Sanz and further in view of Lindsey, and claims 26 and 36 as obvious under 35 U.S.C. 103(a) over Vichai in view of Sanz and further in view of Lindsey and Hair. In the foregoing amendments, independent claims 15, 26 and 36 have been amended to point out and claim the stiffening ring integral with the body for providing resistance to inwards deformation of the mouth of the body. Applicant respectfully requests reconsideration of the rejection of the claims in light of the foregoing amendment and following remarks.

Claim rejections under 35 USC§ 103(a)

Independent claims 15, 26 and 36 as amended includes the limitation of the stiffening ring integral with the body for providing resistance to inwards deformation of the mouth of the body. This feature is of importance as described in connection particularly with the embodiments of Figures 6 and 8 of the application.

The cited references do not disclose or suggest the feature of a stiffening ring integral with the body for providing resistance to inwards deformation of the mouth. Therefore, all these independent claims cannot be rendered obvious by the references. Similarly, since the rejected claims 16-21 and 23-25 are all dependent claims which depend from independent claim 15 and incorporate all of its limitations, these claims also are not obvious.

Initially, it respectfully is submitted that the Examiner has misinterpreted the disclosure of Hair. Hair does not disclose "means which is capable of providing resistance to

inwards deformation of the mouth of the bottle body" as the Examiner has asserted. (See office action, p. 3, lines 4 - 6). Hair cannot provide this element, as the ring disclosed in Hair is neither integral, nor does it provide resistance to inward deformation of the mouth of the bottle body. Hair does not teach the use of a stiffening ring integral with the body for providing resistance to inwards deformation of the mouth of the body. Instead, Hair teaches only a disposable bottle body, made of paper or cardboard, which is used with a non-disposable rim, nipple and cap. Hair references a non-disposable rim 15 which is fitted to the container in order to provide the screw thread to receive the closure 19. The rim 15 is not integral with the container and thus would require additional manufacturing complexity and excessive material wastage if used on a disposable container, as in the present invention. Accordingly, the rim disclosed in Hair would not satisfy the object of the relatively narrow integral stiffening ring of the present invention.

Further, the rim of Hair does not function to prevent inwards deformation of the container walls, as it is possible to press the pliable container sides inwardly anywhere below the rim 15, because the container and rim are not integral and because, due to its disposable nature, the container body of Hair is made of very thin paper or cardboard material. Such displacement of the container body could cause leakage to occur between the container and the closure. The rim 15 of Hair is, therefore, not intended to prevent inwards deformation of the container walls and, indeed, it cannot serve that purpose. In fact, in Hair there is no mention whatsoever of providing resistance to inward deformation of the mouth of the bottle body. Accordingly, even if Hair was combined with all of the other cited references, the combination could not render the present invention obvious.

Because the Examiner has misinterpreted the disclosure of one of the asserted references, Hair, and because the rejection is based on a misinterpretation of fact, as a matter of fact and law,

the rejection should be withdrawn. See Ex parte Porter, 25 USPQ2d 1144, 1147 (BPAI 1992)(reversing a rejection based on a misinterpretation of the disclosure of a reference); Ex parte Levy, 17 USPQ2d 1461, 1465 (BPAI 1990)(same). Moreover, even if the Examiner were correct in her analysis of the disclosure of Hair, the rejection still falls short, because it lacks the requisite suggestion and motivation for *why* one would have selected the references the Examiner selected and *why* one would have been led to combine them as the Examiner did.

While the Examiner acknowledged that none of the four cited references discloses the entire invention as claimed, she asserted that it would have been obvious to modify "the feeding bottle of Vichai in view of Sanz et al. and Lindsey et al. with a thick ring at the mouth of the bottle body, as taught by Hair, in order to provide a rigid structure at the mouth of the bottle body where the connection the cap closure and the bottle body is occurred." (Office action, p. 3, lines 7 - 11).

However, the Examiner never attempted to explain *why* one would have been *led* to deviate from Vichai's teachings and modify Vichai precisely at the stated points, and *why* one would have looked to Sanz, Lindsey, and Hair, rather than any other references, to modify Vichai precisely at those points. But that is what a conclusion of obviousness requires:

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, ***the examiner must show reasons that the skilled artisan***, confronted with the same problems as the inventor and with no knowledge of the claimed invention, ***would select the elements from the cited prior art references*** for combination in the manner claimed.

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In other words, the [Examiner] must explain the reasons that one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious.

In re Rouffet 149 F.3d 1350, 1357, 1359, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1993)(emphasis added).

Thus, because the Examiner failed to identify any suggestion or motivation for *why* one would have been *led* to select and modify the references as the Examiner did, the rejection should be withdrawn for this further reason.

An Examiner "must indicate where a teaching or suggestion appears in the reference." *In re Rinehart*, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). Here, the Examiner did not meet that initial burden. *See also In re Lee*, 61 USPQ2d 1430, 1433-34 (Fed. Cir. 2002) (emphasizing the importance of providing objective evidence and making specific factual findings with respect to the motivation to combine references). As is apparent from a review of the Office action, nowhere is there any evidence or even allegation that one would have been motivated to make the combination the Examiner made.

As the Federal Circuit emphasized in *In re Rouffet*, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998), that something was "known" *per se*, is insufficient to support a rejection under § 103:

As this court has stated, "virtually all [inventions] are combinations of old elements." *Environmental Designes, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); *see also Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements."). Therefore, *an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint for piecing together elements in the prior art to defeat the patentability of the claimed invention. Such an approach would be "an illogical and inappropriate process by which to determine patentability."* *Sensonics, Inc. v. Aerasonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

Thus, because the Examiner has failed to provide the requisite suggestion for why one would have selected the references picked by the Examiner and combined them in a way that

would have resulted in the claims, and because the Examiner has relied on the wrong legal standard, the rejection of all claims should be withdrawn.

It is respectfully submitted that the foregoing amendments and remarks overcome the basis of the Examiner's rejection of the claims under 35 U.S.C. § 103(a). Prompt and favorable reconsideration is respectfully requested. The Examiner is encouraged to contact the undersigned via telephone to resolve any outstanding issues.

Respectfully submitted,

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